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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

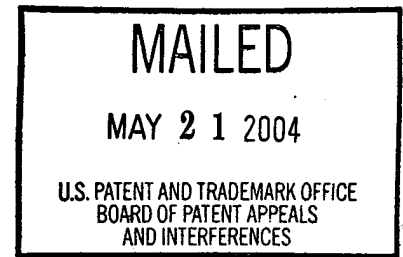
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD R. UDELL, STUART D. BAKER,
CARY S. KAPPEL, GREG M. SHERMAN, and
WILLIAM RIES

Appeal No. 2004-0491
Application No. 09/098,204

HEARD : May 4, 2004



Before KRASS, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, 13-15, 17-19, and 44-47, which are all of the claims pending in this application.

We **AFFIRM-IN-PART**.

BACKGROUND

Appellants' invention relates to a self-destructing document and e-mail messaging system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for creating a self-destructing document, comprising the steps of:

creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based upon a preselected expiration date, is expired;

attaching the executable module to the document.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|----|--|-----------|---------------|
| 1. | Norin et al. (Norin) | 5,787,247 | Jul. 28, 1998 |
| 2. | Beck et al. (Beck) | 5,903,723 | May 11, 1999 |
| 3. | Drake | 6,006,328 | Dec. 21, 1999 |
| 4. | Hansen, W.J., "Enhancing documents with embedded programs: How Ness extends insets in the Andrew Toolkit," IEEE , pp 23-32, 1990. | | |

Claims 1-10, 13-15, 17-19, and 44-47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hansen in view of Beck. Claims 1-10, 13-15, 17-19, and 44-47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Drake in view of Norin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 25, mailed Nov. 5, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 24, filed Aug. 12, 2002) and reply brief (Paper No. 26, filed Jan. 14, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected to group the claims into four separate groups. (See brief at page 4.) We will address appellants' claims with respect to a representative claim from each group. We select independent claims 1, 6, and dependent claims 5 and 18 as the representative claims for the four groups.

INDEPENDENT CLAIM 1

First, we address independent claim 1 and the combination of Hansen and Beck.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is

established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination `only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

From our review of the examiner's rejection in the answer and the teachings of Hansen and Beck and the combination of Drake and Norin, we find Hansen and Drake teach similar teachings with respect to computer viruses and attachment to computer documents and Beck and Norin teach a similar time-based aspect to execution of a

deletion of a file. Therefore, we find that the examiner has established a *prima facie* case of obviousness of the claimed invention with both combinations as will be discussed below.

Appellants argue that the combination of Hansen and Beck does not render the claims obvious. Appellants further argue that Hansen discloses a well-known problem of the Trojan horse-type virus that executes an embedded program attached within a file and that the embedded program can operate on or be destructive towards other files in the user's operating system. (See brief at page 10.) Appellants argue that Hansen does not discuss or suggest an embedded program that operates on the very document to which it is attached, leaving the user no choice as to whether or not to execute it. (See brief at page 4.) We disagree with appellants and find that appellants' specification admits that the first embodiment of the disclosed invention is an executable module in the form of a "Trojan horse" attached to an e-mail or document when it is created. (Specification at pages 2-3.) We find that appellants' specification teaches that Trojan horse executable file is attached to a file and that the file to which it attached is deleted. The specification further states that "the executable module executes each time that a file to which it is attached is opened . . . determines whether a condition precedent to file deletion has been met . . . instructs the computer to overwrite the file with null data, and then to save, close or delete the file."

Here, we note that appellants argued at the oral hearing that the present invention "selectively" deletes "only" the file to which it is attached to without further detrimental deletions as would occur with Trojan horse type viruses. Here, we find that the present claimed invention is not limited to "selective" deletion and deletion of "only" the file to which it is attached. We find that it would have been obvious to one of ordinary skill in the art that a Trojan horse type virus that deletes or overwrites data stored on a user's computer would have eventually overwritten the document or e-mail to which the executable file was attached while carrying out its destruction.

Furthermore, Beck and Norin both teach the time-based expiration of data was well-known, and we further add that it was well-known and would have been obvious to one of ordinary skill in the art that many viruses as disclosed by Hansen and Drake used time as a trigger for their initiation.

As our reviewing court states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys., Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002) **cert. denied**, 123 S.Ct. 2230 (2003).

Appellants argue that Beck provides no solution to the problem stated by appellants of how to automatically delete documents that are scheduled to be deleted

by a document retention program but to which the document retention program has no access because these documents have been saved or forwarded out of the network. (See brief at pages 11-12.) We do not find a clear nexus of this problem to the invention as recited in independent claim 1. Independent claim 1 does not recite any details that the document is remote from a retention program, saved elsewhere or been forwarded. Therefore, we do not find appellants argument relevant to the instant claimed invention.

Appellants argue that Beck does not disclose a document having an attached module, brief at page 12, but Hansen teaches the embedding of scripts which would have been attached executable modules. Appellants argue that even if Hansen and Beck are combined, there is still not teaching or suggestion of a method for creating a self-destructing document in which documents are automatically self-deleted by a computer under control of an executable file that was created for this purpose. As discussed above, we do not find adequate support for appellants' argument with respect to the purpose which appellants impliedly intend to be a selective deletion.

Appellants argue that the examiner's motivation is "completely irrelevant" to appellants' claimed inventions, and the examiner has not provided any proper suggestion or motivation. (See brief at pages 18-21.) We disagree with appellants since the motivation need not be the same as appellants'. Appellants argue that Hansen and Beck teach away from the claimed invention and to the deletion of a

document or e-mail as a solution to a problem. We disagree with appellants and find that while Hansen does teach a methodology to protect a user from execution, Hansen does teach to well-known actions of Trojan horse-type viruses. Therefore, we do not find that Hansen specifically teaches away from the claimed invention, but it actually teaches it in a broad manner.

Appellants argue that Beck teaches away from the claimed invention since Beck teaches and suggests that it is preferable not to attach actual files to an e-mail message. We agree that this is the thrust of Beck, the examiner has relied upon Beck with respect to the limited life of a document wherever it is located. Therefore, we do not find that Beck is a specific teaching away from the claimed invention.

In determining novelty, the first inquiry must be into exactly what the claims define. **In re Wilder**, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Similarly, a section 103 analysis begins with a key legal question -- what is the invention claimed? **Panduit Corp. v. Dennison Mfg. Co.**, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, we do not find that appellants' independent claim 1 is limited to the selective deletion of only the file to which the executable file is attached and therefore the ordinary Trojan horse-type virus using a time as an initiator would have suggested the claimed invention as recited in independent claim 1.

Appellants argue that the examiner's comments with respect to Hypercard do not teach the use of a delete file function to delete the very document to which the executable file is attached. (See reply brief at pages 1-3.) We agree with appellants, but appellants admit that Hansen teaches that viruses may contain a delete file function for deletion of other files. (See reply brief at page 3.) We find this teaching of a file deletion to be a teaching that ultimately the document or e-mail to which the executable file is attached will ultimately be deleted or overwritten. Therefore, we will sustain the rejection of independent claim 1 over the combination of Hansen and Beck, and claims 2-4 and 44-47 which appellants have elected to group therewith.

With respect to the combination of Drake and Norin, appellants argue that Drake does not destroy itself but rather is destroyed by a debugger and that there is no control module embedded in the data since no instructions originating from the data itself direct a processor to execute a deletion process. (See brief at page 26.) We do not find appellants' arguments persuasive since they go beyond the express limitations of independent claim 1. Appellants further argue that Drake does discuss the well-known problem of a Trojan horse-type virus, which executes an embedded program attached within a message to operated on or be destructive towards other files in the user's operating system, but only in the context of what a rogue might attempt to do and how Drake's system avoids such a virus. (See brief at page 26.) We agree with appellants, but note that the teaching of Drake regarding the Trojan horse-type virus is

similar to appellants' first embodiment without the limitation to time or limiting the invention to selective deletion.

Appellants argue that Norin does not teach or suggest that time-deletion of documents is done by the very document to be deleted or that the deletion is performed by an executable module attached to the documents to be deleted. Appellants argue that Norin teaches away from the claimed invention and does not teach the deletion of time-expired data by itself. (See brief at page 27.) We do not find this argument persuasive since we do not find Norin to be a specific teaching away, and we do not find support for the argument that the invention is directed to deletion of time-expired data by itself. We find that this argument goes beyond the express limitations of independent claim 1. Therefore, this argument is not persuasive.

Similarly, we do not find appellants' arguments to the combination of teachings of Drake and Norin and lack of motivation at pages 32-35 of the brief and pages 8-9 of the reply to be persuasive as discussed above with respect to the combination of Hansen and Beck. Since we do not find that appellants have overcome the ***prima facie*** case of obviousness over the combination of Drake and Norin, we will sustain the rejection of independent claim 1 and claims 2-4 and 44-47 which appellants have elected to group therewith.

CLAIMS 6-10, 14-15, AND 17

Appellants argue that Hansen does not teach a self-destructing e-mail messaging system wherein an executable module operates on and self-destructs the very e-mail message to which it is attached, leaving the user no choice as to whether or not to execute the module and delete the e-mail message. (See brief at page 13.) We disagree with appellants and find that the Trojan horse-type virus in an e-mail system would have formed an executable module which would have been attached to e-mail messages by the e-mail system prior to transmission. This Trojan horse-type virus would have either erased data or duplicated itself throughout the storage system as is continued to perform its destruction thereby deleting the e-mail to which it was attached and/or crashing the storage system thereby deleting all data from the storage system.

Appellants argue that Hansen does not teach since the executable module is attached to the e-mail message and directs the processor to delete the e-mail message, then thereby accomplish a self-destruct. (See brief at page 13.) We disagree with appellants as clarified at the oral hearing. Appellants' representative was asked at the Oral Hearing if the attached executable module is deleted, but appellants' representative indicated that the e-mail message or document is deleted and not the executable module that is performing the function of the deleting. Therefore, this argument is not commensurate with the scope of the claim and is not persuasive.

Appellants argue that Hansen is teaching away from the claimed invention. (See brief at page 13.) We disagree with appellants as discussed above. Appellants argue that Hansen does not teach or suggest the use of a predetermined condition. (See brief at page 14.) We agree with appellants, but note that the examiner has relied upon the teachings of Beck with respect to the teaching of time as a condition and appellants admit that Beck is similar to appellants' admitted prior art in appellants' specification. Therefore, this argument is not persuasive.

Appellants argue that Beck still does not present a solution to the problem faced by appellants concerning a document retention program. (See brief at page 14.) We find no basis in the express language of independent claim 6 to support appellants' argument. Therefore, this argument is not persuasive. Appellants argue that Beck does not delete any document or e-mail attached to an attachment. We agree with appellants that Beck teaches using references to documents at remote locations and timed deletion thereof, but we find that the teachings of Hansen provide the base teaching of an attached executable module. Therefore, this argument is not persuasive.

Appellants argue that the examiner's reliance upon the teachings of Hansen are misplaced and that Hansen does not contain any hint of the elements of claims 6 and 17. (See reply brief at pages 4-5.) As discussed above, we find that a Trojan horse-type virus, though not specifically tailored as appellants also employ in their first

embodiment, would have deleted the e-mail or document to which the executable module was attached. Therefore, this argument is not persuasive.

With respect to Drake and Norin, appellants essentially parallel the arguments discussed above with respect to independent claim 1 and the arguments made with respect to Hansen and Beck. Therefore, these argument is not persuasive. Appellants argue that neither Drake or Norin teach an e-mail messaging system. (See brief at page 29.) We disagree with appellants and find that Drake discloses at column 2 the use of electronic mail and automatic execution of attachments. Therefore, this argument is not persuasive.

Appellants argue that Drake mentions an e-mail virus, but that does not accomplish self-deletion of the e-mail message. (See reply brief at page 9.) We disagree with appellants as discussed above with respect to independent claim 1. Therefore, we do not find that appellants have rebutted the examiner's *prima facie* case of obviousness, and we will sustain the rejection of representative independent claim 6 and claims 7-10, 14-15, and 17 which appellants have elected to group therewith.

CLAIMS 5 AND 13

Appellants argue that Hansen does not teach executing the executable module when the document is opened. (See brief at pages 16 and 31.) We agree with appellants that the portions of Hansen and Drake referenced are not the clearest

teachings of executing upon opening, but Hansen's and Drake's disclosure of Trojan horse-type viruses and other viruses clearly begin executing upon opening the document to become active, but the actual deletion may not occur until a later time. Therefore, this argument is not persuasive. It would appear that appellants may have intended that the operation or execution of the module as a condition precedent to the opening or accessing of the document. Dependent claim 5 does not recite such a function. With respect to appellants' argument to self-destruction when a user tries to access the e-mail message. (See brief at page 31.) We do not find that the language of dependent claim 13 supports appellants' argument. Appellants argue that the examiner has not shown where Hansen teaches or suggests the steps of executing the executable module when the document is opened and thereby deleting the document. (See reply brief at pages 5-6.) We disagree with appellants as discussed above. With respect to Drake, appellants argue that viruses damage or delete other files and not self destruction. (See reply brief at page 10.) Here, we find that these viruses will ultimately damage or delete the document or e-mail to which the executable module was attached, and we note that the language of the claims does not preclude damage or deletion of other documents or e-mails. Therefore, we will sustain the rejection of dependent claim 5 and dependent claim 13 which appellants have elected to group with claim 5.

CLAIMS 18 AND 19

Appellants argue that the examiner has not shown the limitations as recited in claims 18 and 19. From our review of the examiner's answer, we find that the examiner has merely grouped these claims as having the same limitations as recited in claims 1-5. (See answer at pages 4 and 5.) Clearly they are not the same. The examiner briefly cites to the teachings of Beck at column 7 teaching encryption and decryption, but this does not address the specific limitations. Therefore, we cannot sustain the rejection of claims 18 and 19 since the examiner has not established a *prima facie* case of obviousness over the teachings of the applied references.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10, 13-15, 17, and 44-47 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 18 and 19 under 35 U.S.C. § 103 is reversed.

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Application No. 09/098,204

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

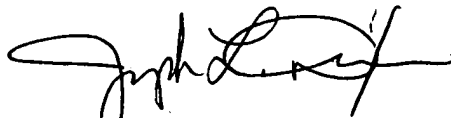
AFFIRMED-IN-PART



ERROL A. KRASS
Administrative Patent Judge



MICHAEL R. FLEMING
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge

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